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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,144	09/12/2003	Philip E. Neff	1745-000001	8735

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EXAMINER

BINDA, GREGORY JOHN

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 03/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/662,144

Applicant(s)

NEFF, PHILIP E.

Examiner

Greg Binda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 28-38 is/are pending in the application.
- 4a) Of the above claim(s) 7, 11, 12 and 33-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10 and 28-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Applicant added new claims 28-38, but failed to indicate which of these claims are readable on the elected species. See MPEP § 809.02(a).

Election/Restrictions

3. Newly submitted claims 34-38 are directed to an invention that is independent or distinct from the invention originally claimed. That is so because the inventions are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (see new claims 34-38) as claimed does not require the particulars of the subcombination in the original claims because it does not require a repair device so constructed that a hub and a shell are allowed to move relative to each other. The subcombination has separate utility such as an original equipment type (i.e. not a repair type) device.
4. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 34-38 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5. Claims 7, 11, 12 & 33-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Applicant elected Group I, Species I, the repair device shown in Figs. 1 & 2, and timely traversed the restriction (election) requirement in the reply filed on September 23, 2004.

Claim Objections

6. Claim 28 is objected to because it includes the term "improved". The term is redundant because if the claimed invention has patentability utility as presumed, then it must be improved over the prior art.

Claim Rejections - 35 USC § 112

7. Claims 28-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "improved" in claim 28 is a relative term which renders the claim indefinite. The term "improved" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

8. Claims 1-5, 8-10 & 28-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Churchill et al, US 5,033,433 (Churchill). Fig. 2 shows a repair device for a flexible drive

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coupling having a shell and a hub, the repair device comprising: a first member 20 adapted to be fixed to the shell 22, the first member including a slot in a bifurcated end 36; and a second member 44 adapted to be fixed to the hub 16, a portion of the second member extending from the hub, the portion being slidably positioned within the slot, the first member being drivingly engagable with the second member to transfer torque between the shell and the hub while allowing the hub and shell to be movable relative to each other. Fig. 2 shows the first member 20 includes inner and outer arcuate walls 34 engaging an outer surface of the shell 22.

9. Claims 1-3, 8-10 & 28-32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by any one of Scott, US 1,277,491 and Cadnum, US 1,833,932.

Claim Rejections - 35 USC § 103

10. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Churchill. Churchill shows a repair device having all the limitations except the second member 44 is shown in the shape of cylinder instead of a shape with planar parallel sidewalls. However, applicant has not disclosed that providing this type of shape is for any particular reason or solves any particular problem. As such, it would have been an obvious matter of design choice to make the second member in a shape with planar parallel sidewalls, since such a modification would have involved a mere change in the shape of the second member. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

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11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cadnum for the same reason noted immediately above.

Response to Arguments

12. Applicant's arguments filed Jan 25, 2005 have been fully considered but they are not persuasive.

- a. Applicant argues that cited prior art fails to disclose a repair device as defined in claim 1. That argument fails to comply with 37 CFR 1.111(b) because it amounts to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.
- b. In response to applicant's argument that the repair device in the claims is novel because it is intended to be used with a shell and hub, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cyr discloses in col. 3, lines 50-53 that an article like instant second member 72 can be made cylindrical or with planar parallel surfaces without any effect on its ability to perform its intended function.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. This application contains claims 7, 11, 12 & 33-38 drawn to an invention/species nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (703) 305-2869. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Greg Binda
Primary Examiner
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